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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,660	03/29/2004	Patrick Thomas McQuary		2446

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Mr. Patrick Thomas McQuary
29 Orsinger Hill
San Antonio, TX 78230

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.	Applicant(s)	
10/811,660	MCQUARY, PATRICK THOMAS	
Examiner	Art Unit	
Susanna M. Diaz	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-3 are presented for examination.

Claim Objections

2. Claim 1 is objected to because of the following informalities:

Claim 1, line 5, insert – be—before “used”

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 2 and 3 are hybrid claims since they are directed toward a system (i.e., apparatus) and method (i.e., process). Claims should be limited to one statutory class. Since claims 2 and 3 are not limited to one statutory class, they are deemed to be non-statutory (see MPEP § 2173.05(p)(II)).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3 are hybrid claims since they are directed toward a system (i.e., apparatus) and method (i.e., process). Claims should be limited to one statutory class. As per MPEP § 2173.05(p)(II), "A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph." See *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson (U.S. Patent No. 5,863,074) in view of Brikho (US 2004/0026500 A1) in view of Farrar et al. (U.S. Patent No. 6,647,376).

Wilkinson discloses a method for identification of a payor of a negotiable instrument by a merchant payee, comprising the steps of:

[Claim 1] (a) the step of preparing printed checks or other negotiable instruments for the payor's signature, superimposed with an identical image of the payor that is to be used by the payor as identification when presenting said negotiable instrument to payee (Figs. 1-4; col. 4, lines 37-45);

(b) the step of the payor presenting said negotiable instrument with an image of payor's photographic identification superimposed (col. 6, lines 4-7); and,

(c) the step of the merchant payee identifying the payor by verification of the identifying information on the negotiable instrument by comparison with that information on the photographic identification provided by the payor (col. 6, lines 4-7 – The photograph of the payor should resemble the payor him/herself).

Wilkinson does not expressly disclose that the printed checks or other negotiable instruments are printed by the payor's financial institution; however, the manipulative steps and structural elements of the claimed invention are not affected by who prints the checks. Therefore, the details of who prints the checks will not serve to patentably distinguish the claimed invention over the prior art.

While Wilkinson prints a check payor's photograph on the payor's checks and such an image may be input through a scanner (col. 5, lines 20-23), Wilkinson does not expressly state that the photograph is obtained from a government issued photographic identification card; however, Brikho also discloses the concept of imprinting a payor's

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photograph on checks to prevent fraudulent check writing (abstract; ¶ 62). Brikho states that the imprinted picture may be "scanned in from the customer's drivers' license" (¶ 62), which is a government issued photographic identification card. Since Wilkinson is expressly amenable to using scanned photographs of the check payor, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Wilkinson to expressly utilize a photograph of the payor from the payor's drivers license (i.e., a government issued photographic identification card) since drivers license photos are more standardized in nature and are harder to falsify than a random, personal photograph, thereby providing merchants with a more commonly recognized and trustworthy system of verifying payors' identities.

Additionally, neither Wilkinson nor Brikho expressly teaches that the photograph on the payor's check is further verified against the payor's photograph on an actual government issued photographic identification card. However, Wilkinson describes itself as an improvement over the previous check authentication method of identifying a person cashing a check (col. 1, lines 23-27). Also, Farrar discloses that a merchant can request that a check payor present his/her drivers license as an additional identity verification, thereby improving confidence in the determination that the payor is authorized to write the check (col. 22, lines 8-15). This practice helps to assure the merchant that the check is legitimate. Also, many merchants note the drivers license number on the check itself in case there is a problem with cashing the check, so that any problems with payment may be rectified later. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of

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Applicant's invention to modify the Wilkinson-Brikho combination such that a merchant payee further verifies the payor's identification by comparing the check or other negotiable instruments with the information on the actual photographic identification provided by the payor in order to increase the security measures in identifying the payor while helping to ensure the merchant that the check is legitimate and providing the merchant with a way to track down the payor if there is a problem with cashing the check, so that any problems with payment may be rectified later.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references disclose the concept of printing a payor's or payee's photograph on a check:

Lumpkin (US 2003/0083993 A1)

Holloway, Jr. (US 2003/0023556 A1)

Maynard (US 2005/0149441 A1)

Cousins et al. (US 2003/0115470 A1)


Goldwater (U.S. Patent No. 2,462,735)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Susanna M. Diaz
Primary Examiner
Art Unit 3694

September 27, 2007